

Application No.: 09/577,790

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REMARKS

Claims 1-3, 5-15, 17, 19, 21 and 24 are currently pending in this application. Claim 23 is cancelled herein. Reconsideration is respectfully requested in view of the above amendments and the following remarks.

Applicant's Response to 35 U.S.C. § 103 Rejection over Schmitt in view of Kramer

Claims 1-3, 5, 6, 9-15, 17, 19 and 23 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,443,499 to Schmitt (hereinafter "Schmitt") in view of U.S. Patent No. 5,871,468 to Kramer et al (hereinafter "Kramer"). Applicant respectfully traverses the rejection on the basis that the combination of references fails to render the claims *prima facie* obvious.

In particular, contrary to the Examiner's allegations, the cited references fail to disclose or suggest a combination of undrawn and partially drawn radial filaments, as required in Applicant's claims.

More specifically, the Examiner asserts that "Schmitt discloses the plurality of polymeric filaments comprise a combination of undrawn and partially drawn radial filaments . . ." (Office Action, at 2). For support the Examiner cites column 4, lines 51-58 and column 6, lines 48-57 of Schmitt. The disclosure appearing at column 4, lines 51-58, however, relates to a prosthesis containing undrawn or partially drawn radial yarns, not combinations of undrawn and partially drawn radial yarns. More particularly, column 4, lines 51-58 of Schmitt reads as follows:

It has been discovered however, that if a prosthesis is woven with undrawn or partially drawn radial yarns, the prosthesis will be capable of circumferential expansion following manufacture of the product. More particularly, if a balloon catheter (or similar device) is inserted into such a prosthesis and is thereafter expanded, the prosthesis will circumferentially expand a slight degree until the yield point is reached.

(emphasis added).

The disclosure appearing at column 6, lines 48-57 similarly relates to a prosthesis containing undrawn or partially drawn radial yarns. Such disclosure reads as follows:

The undrawn or partially drawn yarns are incorporated into the chosen textile pattern in the direction which upon drawing will result in a larger diameter of the device. In the case of woven patterns, the undrawn materials make up the fill yarns. In the case of knitted construction, such as weft knits, or braided patterns such as two dimensional, multi-ply or three dimensional braids, the undrawn yarns may comprise part of or all of the fabric. The same applies to grafts made from filament winding construction.

(emphasis added).

As seen in the above passages, the express language of Schmitt plainly states “or,” i.e., undrawn “or” partially drawn filaments. Reading Schmitt as “and,” as the Examiner has done, is contrary to the express language of the reference. Moreover, producing a Schmitt prosthesis with undrawn “and” partially drawn radial filaments would be contraindicative to one of ordinary skill in the art. Such construction would lead to unevenness during the *in vivo* stretching of the Schmitt prosthesis because the undrawn filaments would stretch more than the partially drawn filaments. The resulting product would create a turbulent blood flow. In view thereof, the Examiner is impermissibly modifying the express language of Schmitt.

Therefore, both of the passages from Schmitt, cited by the Examiner and recited above, disclose the use of radial filaments that are either undrawn or partially drawn. This is distinct from a combination of undrawn and partially drawn radial filaments, as recited in Applicant’s claims. Further, as indicated in the second passage above, Schmitt specifically states that the radial, or fill, yarns, are undrawn in woven patterns. There is no suggestion or motivation to modify Schmitt to incorporate both undrawn and partially drawn radial filaments in a woven construction.

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In view thereof, Schmitt fails to expressly disclose or suggest a combination of undrawn and partially drawn filaments in the radial direction for woven constructions.

Furthermore, the Examiner alleges that “[s]ince the patent to Schmitt has the same figures it must inherently have ‘both undrawn and drawn yarns in the radial direction’.” (Office Action, at 6).

Applicant respectfully submits that Figures 1 and 2 of Schmitt do not inherently disclose a combination of undrawn and partially drawn yarns in the radial direction.

Applicant pointed to Figures 1 and 2 of the present application (in the Response dated February 28, 2005) as support for the amendment defining the woven textile construction of the implantable prosthesis fabric. More specifically, Figures 1 and 2 show that the woven construction includes a plurality of radial filaments and a plurality of longitudinal filaments. The figures evidence that the longitudinal filaments are disposed longitudinally along the length of the prosthesis, and the radial filaments are disposed generally perpendicular to the longitudinal filaments. Therefore, the purpose of Figures 1 and 2 is to depict a basic woven construction. No indication of filament arrangement is provided by the figures in the present application or Schmitt. The filaments may be a variety of different types.

Therefore, Figures 1 and 2 do not require the radial filaments to include a combination of undrawn and partially drawn filaments. Only Applicant’s specification teaches such combinations. In accordance therewith, Applicant relied on pages 12-13 of the specification when adding the combination of undrawn and partially drawn radial filaments to its claims. (Amendment and Response dated March 15, 2004, at 8).

Because Figures 1 and 2 could encompass a variety of radial filaments, the radial filaments shown in the figures are not necessarily a combination of undrawn and partially drawn filaments. As set forth in MPEP §2112, Part IV:

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To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’

(quoting *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999)) (emphasis added).

Therefore, because a combination of undrawn and partially drawn radial filaments is not necessarily present in Figures 1 and 2 of Schmitt, inherency of such feature is not established.

In view thereof, the combination of undrawn and partially drawn radial filaments, as recited in Applicant’s independent claims 1, 11 and 17 is missing from Schmitt. Such recitation is not taught expressly or inherently by Schmitt. Moreover, Kramer is cited merely for its alleged disclosure of two naphthalene dicarboxylate derivatives and bears no relevance to this missing limitation. Therefore, Kramer fails to cure the deficiencies of Schmitt as a reference. As such, it is respectfully submitted that there is no *prima facie* showing of obviousness based on the cited combination.

In view of the foregoing remarks, it is respectfully submitted that claims 1, 11 and 17, along with dependent claims 2, 3, 5, 6, 9, 10, 12-15 and 19 are patentable over Schmitt and Kramer, each taken alone or in combination.

Applicant’s Response to 35 U.S.C. § 103 Rejection over Schmitt in view of Kramer and Kuwahara

Claim 8 is rejected under 35 U.S.C. § 103(a), as allegedly being obvious over Schmitt in view of Kramer and WO 99/04727 to Kuwahara (hereinafter “Kuwahara”). Applicant respectfully traverses the rejection on the basis that the combination of references fails to render

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the claim *prima facie* obvious.

Claim 8 depends from claim 1, and thus, requires all of the limitations of claim 1. As discussed in detail above, Schmitt fails to disclose or suggest a prosthesis having a woven construction in which the radial filaments include a combination of undrawn and partially drawn filaments. Kramer fails to cure the deficiencies of Schmitt in this regard. Kuwahara, which is cited merely for its disclosure of coating a prosthesis, also fails to cure the deficiencies of Schmitt in this regard.

Therefore, claim 8 is not obvious in view of the teachings of Schmitt in combination with Kramer and Kuwahara. It is respectfully submitted that claim 8 is patentable over Schmitt in view of Kramer and Kuwahara, each taken alone or in combination.

Applicant's Response to 35 U.S.C. § 103 Rejection over Schmitt in view of Kuwahara and Schmitt '970

Claim 21 is rejected under 35 U.S.C. § 103(a), as allegedly being obvious over Schmitt in view of Kuwahara and U.S. Patent No. 5,697,970 to Schmitt (hereinafter "Schmitt '970"). Applicant respectfully traverses the rejection on the basis that the combination of references fails to render the claim *prima facie* obvious.

As in claims 1, 11 and 17, discussed above, claim 21 requires a combination of undrawn and partially drawn radial filaments. Also as discussed in detail above, Schmitt fails to disclose such recitation, either expressly or inherently, and Kramer fails to cure the deficiencies of Schmitt in this regard.

With respect to claim 21, Schmitt '970 is cited merely for its disclosure of adding crimps to a prosthesis. Schmitt '970 fails to cure the deficiencies of Schmitt and Kramer with respect to claim 21. Therefore, claim 21 is not obvious in view of the teachings of the cited combination, and it is respectfully submitted that claim 21 is patentable over Schmitt in view of Kramer and

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Schmitt '970, each taken alone or in combination.

Applicant's Response to 35 U.S.C. § 103 Rejection over Schmitt in view of Kuwahara

Claim 24 is rejected under 35 U.S.C. § 103(a), as allegedly being obvious over Schmitt in view of Kuwahara. Applicant respectfully traverses the rejection on the basis that the combination of references fails to render the claim *prima facie* obvious.

Similar to claims 1, 11, 17 and 21, discussed above, claim 24 also requires a combination of undrawn and partially drawn radial filaments. Again, Schmitt fails to disclose such recitation, either expressly or inherently. Moreover, with respect to claim 24, Kuwahara is cited merely for its disclosure of fibers made of PEN. Kuwahara, therefore, fails to cure the deficiencies of Schmitt as a reference.

Therefore, claim 24 is not obvious in view of the teachings of Schmitt in combination with Kuwahara. It is respectfully submitted that claim 24 is patentable over Schmitt and Kuwahara, each taken alone or in combination.

Should the Examiner have any questions or comments concerning the above, the Examiner is respectfully invited to contact the undersigned attorney at the telephone number given below.

Respectfully submitted,

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